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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/914,789	06/28/99	KATZ	C

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LM02/0618

MARSH, EXAMINER

ART/UNIT	PAPER NUMBER
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06/18/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/914,789

Applicant(s)
Katz et al.

Examiner
Philip Marsh

Group Art Unit
2765



☒ Responsive to communication(s) filed on Mar 29, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 29, 1999 have been fully considered but they are not persuasive.
2. Applicant did not respond to the original rejections made by the Examiner in paper no. 5, but rather anticipated possible arguments regarding the newly amended claims. Nonetheless, the Examiner will explain why Applicant's arguments are not persuasive in view of the prior art.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. In response to applicant's argument that Zoffel et al. do not teach or suggest extracting financial regulatory data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The fact that Zoffel et al. extracts financial data which may or may not be regulatory in nature does

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not distinguish the claimed invention over the system of Zoffel as used applied in conjunction with Prince and CFI, as cited in paper no. 5.

5. Regarding Applicant's assertion that Zoffel et al. Do not teach or suggest reformatting data, the Examiner respectfully disagrees. As pointed out by Applicant, "Zoffel et al. Teach the reformatting of data for a report for the credit report requester". This is equivalent to the claimed invention which claims "reformatting said data into formatted data" as the data in the Zoffel system is reformatted into formatted data as claimed in the present invention.

6. Regarding Applicant's assertion that Zoffel et al. Do not teach or suggest integrating data with previously stored data, the Examiner respectfully disagrees. The system in Zoffel is interested in receiving and merging the credit reports from the three major repositories, and does so as illustrated in Fig. 3. Step 3 is a repository request followed by step 4 where the credit reports are delivered by the repositories. After the reports have been received, they are merged in step 5.

7. Regarding Applicant's assertion that Zoffel et al. do not teach preparing reports on a periodic basis, the Examiner respectfully disagrees. Webster's *New Riverside University Dictionary* defines periodic as "taking place now and then: intermittent". Zoffel's system certainly does prepare reports "now and then". Furthermore, the Zoffel reference should not be considered alone as the rejection was presented in view of Prince and in further view of CFI, which teaches a method of automatically generating reports in electronic formats regarding fair

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lending laws. These laws include the requirement of “periodic” generation, or preparation, of such reports.

8. In response to applicant's argument that Zoffel et al. does not transmit reports to regulators, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As the system taught by Zoffel teaches transmission of reports, and CFI teaches a method of automatically generating reports in electronic formats regarding the fair lending laws, the combination of the two, as applied in paper no. 5 teaches all of the claimed limitations in this regard.

9. Regarding Applicant's argument that CFI or Prince do not explicitly teach normalization of data, the Examiner concurs. However, neither CFI nor Prince was relied upon for the teaching of the normalization of data as the Examiner took “official notice” that normalization of data is old and well-known in the art of financial institution reporting in paper no. 5, paragraph 16.

10. Regarding Applicant's argument that the motivation to combine Zoffel et al., CFI and Prince is improper, the Examiner respectfully disagrees. Since neither Prince nor CFI are relied upon for teaching normalization techniques, this argument is moot. The Examiner would like to clarify, however, that the statements that CFI and Prince teach techniques that, while not stating

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it explicitly, would likely incorporate normalization techniques, are used as support for motivation in combining the Examiner's "official notice" that normalization of data is old and well-known in the art of financial institution reporting with the system of Zoffel.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. Regarding Applicant's assertion that Zoffel et al. Does not teach feeds from a plurality of business units, the Examiner respectfully disagrees. It is clear that TRW, CBI, and Trans Union are separate business entities, or units, within the Associated Credit Bureaus, Inc., a single financial institution.

In response to Applicant's argument that Zoffel et al. in view of Prince and in further view of CFI is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this

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case, Zoffel et al. is a system that deals in lending or credit information, and the teachings in Prince and CFI also concern lending, which is what the present application is concerned with.

12. In response to Applicant's argument that Zoffel et al. does not expressly teach or suggest standardizing, the Examiner respectfully disagrees. Zoffel teaches a system in which data items are "merged into a single report which is formatted for easy reading." (Column 3, lines 24-30). Inherent to merging data items into a single, formatted report is the use of a standardized form. This is true regardless of whether the incoming data is in different formats or not. The report is in a formatted report, which requires at least internal standardization.

13. Regarding Applicant's arguments that Zoffel et al. store the reports, not the data used to generate the reports, the Examiner respectfully disagrees. While it is true that the reports are stored, inherent to storing the reports is the storing of the data contained within the reports. Furthermore, as discussed in conjunction with Fig. 3, data from all of the credit repositories is received and then compared, and then this data is further merged to create one report. Inherent in receiving the data for comparison is storing the data, at least temporarily.

14. Having discussed each of Applicant's arguments, the original rejections in view of the prior art are maintained.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claimss 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As amended, these claims recite an invention which does not have a practical application within the technological arts. It is unclear whether the claims as presently written are accomplished by some sort of computing device or by pencil and paper.

Claim Rejections - 35 USC § 103

17. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

18. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoffel et al. in view of Prince and in further view of CFI, as cited in a prior office action (paper no. 5).

19. As per claims 1-22, paper no. 5, paragraphs 14-24 point out how the references, listed above, teach all of the limitations of the original claims. Paragraphs 1-14, above, discuss how the prior art rejections can be maintained in view of the amendments filed on March 9, 1999, as Applicant has stated that these arguments were filed "[t]o the extent that any of the rejections might still be applied to the claims currently pending" in their amended form. Having responded to each of these arguments above, the rejection of the original office action is maintained.

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Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Marsh whose telephone number is (703) 305-0434. The examiner can normally be reached Monday-Thursday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PWM

Eric W. Stamber

ERIC W. STAMBER
PRIMARY EXAMINER